

Notice of Allowability

Application No.

10/726,131

Examiner

Rita J. Desai

Applicant(s)

GERSTER ET AL.

Art Unit

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 1/26/04.
2. ☒ The allowed claim(s) is/are 24 and 25.
3. ☐ The drawings filed on _____ are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☒ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☒ Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date 1/26/04
4. ☐ Examiner's Comment Regarding Requirement for Deposit
of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☒ Interview Summary (PTO-413),
Paper No./Mail Date 5/20/04.
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____.

Rita J. Desai
Primary Examiner
Art Unit: 1625

DETAILED ACTION

Priority

The priority to US 10/370804, 10/192416, 09/961738, 09/361544 and 60/094346 has been acknowledged.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 25 and 24 in part, drawn to compounds which are N-oxides of formula II classified in class 546, 514 and various subclasses.
- II. Claims 26-36, drawn to method of treating cytokine biosynthesis and viral diseases, classified in class 514 and various subclasses.
- III. Claims 37-44, drawn to compounds and pharmaceutical composition as given in formula I in claim 37, classified in various classes and subclasses. A further election of a single disclosed species for search purposes is required.
- IV. Claims 45-55, drawn to a method of treating using compounds of formula 1 as given in claim 37, classified in various classes and subclasses.
- V. Claims 56-61, drawn to compounds wherein R3 and r4 form a fused alky ring, classified in class 546 and various subclasses. A further election of a single disclosed species is required.
- VI. Claims 62-72, drawn to method of treating using the compounds as given by formula I of claim 56, classified in class 514 and subclasses.

The inventions are distinct, each from the other because of the following reasons:

Inventions I, III and V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are drawn to a compounds of a different core. Some are tricyclic and others are bicyclic and with other hetero rings.

Inventions II, IV and VI are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case these are method of using the compounds. Group IV is drawn to a method of using the compounds in group III and Group VI is drawn to using the compounds of group V.

There are numerous drugs available for the use of inducing cytokine biosynthesis and viral diseases.

Rejoinder:-

If the compounds are found to be allowable then the method of treating will be rejoined limited to the scope of the compounds.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Art Unit: 1625

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II or III or IV-VI, restriction for examination purposes as indicated is proper.

During a telephone conversation with Mr. Ersfeld on 5/20/04 a provisional election was made with traverse to prosecute the invention of Group I, claims 24 and 25.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

EXAMINER'S AMENDMENT

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Mr. Ersfeld on 5/20/2004.

The application has been amended as follows:

Cancel non elected claims 26-72.

In the first line of the specifications please enter

Art Unit: 1625

This application is a divisional of

10/370,804, filed on February 20, 2003, now allowed, which is a divisional of U.S. Application No. 10/192,416, filed July 10, 2002, now U.S. Patent No. 6,627,640, which is a divisional of U.S. Application No. 09/961,738, filed on September 24, 2001, issued as U.S. Patent No. 6,440,992, which is a divisional of U.S. Application No. 09/593,434, filed June 14, 2000, issued as U.S. Patent No. 6,323,200, which is a divisional of U.S. Application No. 09/361,544, filed July 27, 1999, issued as U.S. Patent No. 6,110,929, which claims benefit of Provisional Application No. 60/094,346.

Reasons for Allowance:-

The following is an examiner's statement of reasons for allowance:

The claims 24 and 25 are found to be allowable over the prior art of record.

Closest Art is WO 98/42712 does teach similar compounds but the date is after the applicants priority date. And also the disclosure is within a large genus, hence non-obvious.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rita J. Desai whose telephone number is 571-272-0684. The examiner can normally be reached on Monday - Friday, 9:30 am to 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane can be reached on 571-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1625

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'R. Desai', with a long horizontal line extending from the bottom of the signature.

Rita J. Desai
Primary Examiner
Art Unit 1625

R.D.
May 20th 2004.